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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/712,268	11/15/2000	Takashi Suzuki	862.C2050	8788
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FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
			EXAMINER GIBBS, HEATHER D	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/712,268

Applicant(s)

SUZUKI, TAKASHI

Examiner

Heather D Gibbs

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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DETAILED ACTION

*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 6, 9, 11-13, 15, 18, 20, 22, 25-27, 29, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads (U.S. Patent No. 6,345,104).

For claims 1 and 13, Rhoads discloses an information processing apparatus and method capable of controlling read operation of an original image by a scanner via a scanner driver, comprising a determination means for determining by the scanner driver whether digital watermark information is embedded in image data read by the scanner (Abstract; col. 7, lines 13-64); and control means for controlling predetermined image processing for the read image data on the basis of a determination result by the determination means (col. 14, lines 50-63). Claim 20 is a computer readable medium storing the program to execute the method rejected above, therefore it is reject for the same reason stated.

For claims 3 and 15, Rhoads discloses a display means and method for displaying a warning message representing that the image data is processed to match the specific image data when the predetermined image processing is performed for the read image data wherein the control means discards the read and processed image data on the basis of an

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image processing request from a user in response to the warning displayed on the display means (col. 14, lines 50-57). Claim 22 is a computer readable medium storing the program to execute the method rejected above, therefore it is reject for the same reason stated.

For claims 6 and 18, Rhoads discloses specific image data of an original whose copying operation is prohibited by law (col. 14, lines 55-57).

For claim 9, Rhoads discloses an apparatus and method wherein the digital watermark information is embedded in the specific image data at a predetermined cycle (col. 25, lines 20-26).

For claim 11, Rhoads discloses an apparatus and method wherein the digital watermark information includes invisible or visible information (col. 3, lines 1-22).

Regarding claim 12, Rhoads teaches comprising storage means for storing image data read by the scanner, wherein said control means also processes an image stored in said storage means (Fig 11).

For claims 25 and 29, Rhoads discloses an apparatus and method for extracting, by the scanner driver, digital watermark information embedded in image data read by the scanner (Abstract; col. 7, lines 13-64); and image processing means for processing the image data on the basis of an extraction result from the information extraction means (col. 14, lines 50-63). Claim 30 is a computer readable medium storing the program to execute the method rejected above, therefore it is reject for the same reason stated.

For claim 26, Rhoads discloses a selection means for causing a user to select whether to process the image data by the image processing means (col. 14, line 50 – col. 15, line 7).

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For claim 27, Rhoads discloses a selection means which displays whether to process the image data on display means, thereby causing the user to select whether to process the image data (col. 14, lines 50-57).

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (U.S. Patent No. 6,345,104).

For claim 10, Rhoads does not directly teach the digital watermark includes, as code information, information about the type of specific image data, an issue country, an issue number, and a value. However, Rhodes discloses the use of watermarking technology to encode documents such as currency with multi-bit binary information (Abstract; col. 1, lines 24-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to consider that the basic information about a currency note would be conveyed in the watermarking system disclosed by Rhoads.

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5. Claims 2, 5, 14, 16, 21, 24, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (U.S. Patent No. 6,345,104) as applied to claim 1 above, and further in view of Hasuo et al. (U.S. Patent No. 5,583,614).

For claims 2 and 14, Rhoads fails to disclose an apparatus and method wherein the control means processes the read image data into image data different from the read image data when the determination means determines that the read image data substantially matches the specific image data.

For claims 2 and 14, Hasuo discloses an apparatus and method wherein the control means processes the read image data into image data different from the read image data when the determination means determines that the read image data substantially matches the specific image data (Fig. 6; col. 6, lines 42-51). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the image processing apparatuses of Rhoads and Hasuo because both teach apparatuses which use digital watermarking technology to convey hidden information in documents. The improvement on Rhoads by Hasuo would allow for increased security in document duplication. Claim 21 is a computer readable medium storing the program to execute the method rejected above, therefore it is reject for the same reason stated.

For claims 5 and 16, Rhoads fails to disclose an apparatus and method wherein the predetermined image processing includes resolution conversion processing of converting a resolution of the read image data, color conversion processing of converting color tone of the read image data, and image conversion processing of adding arbitrary image data to the read image data.

For claims 5 and 16, Hasuo discloses an apparatus and method wherein the predetermined image processing includes resolution conversion processing of converting a resolution of the read image data, color conversion processing of converting color tone of the read image data, and image conversion processing of adding arbitrary image data to the read image data (col. 11, line 44 – col. 12, line 8; col. 6, lines 42-51). Claim 24 is a computer readable medium storing the program to execute the method rejected above, therefore it is reject for the same reason stated.

For claim 28, Hasuo discloses a processing means which overlays the information extracted by the information extraction means on the image data (col. 6, lines 42-51).

5. Claims 4, 17, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (U.S. Patent No. 6,345,104) as applied to claim 1 above, and further in view of Zhao et al. (U.S. Patent No. 6,754,822).

For claims 4 and 17, Rhoads fails to teach an apparatus and method wherein the control means creates a log information from which a read processing status of the specific image data can be verified, and registers the log information in a nonvolatile memory on the basis of the image processing request from the user in response to the warning message displayed on the display means.

For claims 4 and 17, Zhao discloses and technique for digital authentication wherein an active watermark contains code that may be executed when the watermark is read (Abstract). Zhao further discloses that the program contained in this active watermark can perform any action in a computer system, which can be describe in the computer code (col. 12, lines 25-58). It would have been obvious to one of ordinary skill in the art at the time

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the invention was made to combine the image processing apparatuses of Rhoads and Zhao because both disclose systems which use digital watermarks to process information. The improvement on Rhoads by Zhao would allow for a log to be created of scanned documents. Claim 23 is a computer readable medium storing the program to execute the method rejected above, therefore it is reject for the same reason stated.

7. Claims 7-8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (U.S. Patent No. 6,345,104) as applied to claim 1 above, and further in view of Lahmi (U.S. Patent No. 5,982,956).

For claims 7 and 19, Rhoads fails to disclose an apparatus and method wherein the specific image data is stored and managed in advance so as to be updateable.

Lahmi discloses an apparatus and method wherein the specific image data is stored and managed in advance so as to be updateable (col. 17, line 31 – col. 18, line 62). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the image processing apparatuses of Rhoads and Lahmi because both teach apparatuses and methods for copying secure documents. The improvement on Rhoads by Lahmi would allow for the ability to upgrade secure documents.

For claim 8, Rhoads fails to teach that the scanner can be connected via a local interface or a network interface.

Lahmi discloses that the scanner can be connected via a local interface or a network interface (Fig. 8; col. 6, line 59 – col. 7, line 3).

### *Conclusion*



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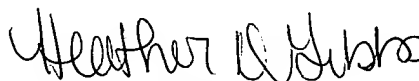
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure Zhao et al. (U.S. Patent No. 6,243,480) discloses digital authentication with analog documents.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D Gibbs whose telephone number is 703-306-4152. The examiner can normally be reached on M-F 8AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

hdg

  
Heather D Gibbs  
Examiner  
Art Unit 2622

  
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